



02 OCT 2002

MaryRose Scozzafava, Ph.D.
Hale and Dorr LLP
60 State Street
Boston, MA 02109

In re Application of :
Dosuk D. Lee et al. :
Application No.: 09/284436 :
PCT No.: PCT/US97/18528 :
Int. Filing Date: 16 October 1997 : DECISION
Priority Date: 16 October 1996 :
Attorney's Docket No.: 04712/02000F :
For: Bioceramic Compositions :

This is a decision on applicants' "Petition Pursuant To 37 CFR § 1.137(b) To Revive An Unintentionally Abandoned Patent Application" filed on 29 July 2002, which is being treated under 37 CFR 1.181, 37 CFR 1.137(b) and 1.497(d).

DISCUSSION

Petition Under 37 CFR 1.181

As a preliminary matter, it is noted that the instant petition indicates that "a timely response was indeed filed on 27 November 2001, a copy of which is enclosed with this Petition." The petition is accompanied *inter alia* by a copy of the "Response Notice..." of 27 November 2001, which includes a Certificate of Mailing Under 37 CFR 1.8. 37 CFR 1.8(b) provides that

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding is dismissed, or terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

- (1) Informs the office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
- (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
- (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the transmission was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

The instant submission satisfies requirements of 37 CFR 1.8(b)(1) and (2). However, the requirements of 37 CFR 1.8(b)(3) have not been satisfied because the statement included in the instant petition is on the part of Mary Rose Scozzafava, rather than by the party who signed the Certificate of Mailing (Michael Leccese); thus, it is not clear that the statement is made on the basis of first-hand knowledge. As such, it would not be appropriate to grant relief under 37 CFR 1.8(b) on the basis of the present record.

Petition Under 37 CFR 1.137(b)

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), this application became abandoned with respect to the United States for failure to timely reply to the Decision mailed 01 October 2001. Applicants have filed the required reply in the form of a response to that Decision.

Regarding requirement (2), the petition includes authorization to charge the petition fee to counsel's Deposit Account, No. 08-0219.

Regarding requirement (3), the petition includes a statement that "the non-receipt by the PTO of the November 27, 2001 response was unintentional." This statement is being construed as a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

Petition Under 37 CFR 1.497(d)

A grantable petition under 37 CFR 1.497(d) must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part; (2) an oath or declaration by the actual inventor or inventors as required under 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (3) the petition fee set forth in 37 CFR 1.17(I); and (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (*See* 37 CFR 3.73(b)). *See* Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.). Requirements (1), (2) and (3) already have been satisfied.

Regarding requirement (4), the "Petition to Correct inventorship-- Consent of Assignee" and "Certificate Under 37 CFR 3.73(b)" already of record provide the consent of Etex Corporation. The instant petition is accompanied by a verified statement that Etex is the sole owner of the above referenced patent application. This verified statement is accepted in satisfaction of the requirement of the Decision mailed on 01 October 2001 to clarify the assignment status of this application and, if Etex is not the assignee of the entire interest, to provide the consent of any other assignee. As such, requirement (4) has now been satisfied.

CONCLUSION

The petition under 37 CFR 1.181 is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **GRANTED**.

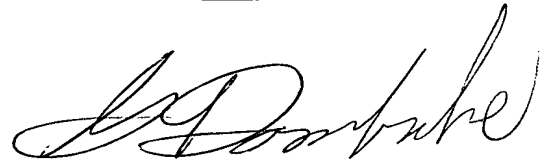
The petition under 37 CFR 1.497 (d) is **GRANTED**.

Counsel's Deposit Account No. 08-0219 is being charged in the amount of \$620.00 as the petition fee under 37 CFR 1.137(b), as authorized by the petition.

This application is being forwarded to the National Stage Processing Branch for further processing. The date of the application under 35 U.S.C. 371 is **08 June 2000**.



Leonard Smith
PCT Legal Examiner
PCT Legal Office



George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459